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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,085	08/17/2007	William H. McNamee	118989-06068225	8794
20583	7590	12/15/2009	EXAMINER	
JONES DAY			VALDEZ, DEVE E	
222 EAST 41ST ST			ART UNIT	
NEW YORK, NY 10017			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,085	Applicant(s) MCNAMEE ET AL.	
	Examiner DEVE VALDEZ	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/14/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

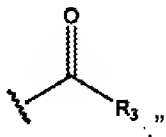
DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 23-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose "i) R^3 independently represents a C_1 to C_{21} hydrocarbyl group; ii) on average at least 1.2 of the R^2 groups is or comprises a C_4 to C_{21} hydrocarbyl group comprising at least two

ethylenic double bonds; and iii) the acyl group is represented by 

Furthermore, the claims recite "a mixture of compounds," there is no support in the specification for this language limitation. Appropriate correction is needed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The claim recites “at least 1.2 of the R² groups,” it is unclear what the applicant is indicating 1.2 units or 1.2%. Clarification is needed.

5. Claims 23-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite, “a mixture of compounds,” it is unclear whether the “mixture” is the compound by itself or if the “mixture” is the compound and another component. Clarification is needed.

6. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites, “the range from 100 to 250 with alkoxyated R¹ group,” it is unclear what the applicant is indicating 100 to 250 weight, %, or units. Clarification is needed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by **CARPENTER** et al. (U.S. Patent Application Publication 2003/0153787, hereafter **CARPENTER**).

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9. Regarding claims 23, 27, and 28, **CARPENTER** teaches compounds of the

formula (1):
$$R^2 \cdot [(AO)_n \cdot R^3]_m$$

Where: R^2 is the residue of a groups having at least m active hydrogen atoms derived from hydroxyl and/or amino and/or amido groups; AO is an alkylene oxide residue; each n is independently from 2 to 200; m is 2-10; and each R^2 is the residue of a group having at least m active hydrogen atoms derived from hydroxyl and/or amino and/or amido groups. R^3 is H, hydrocarbyl, particularly a C_1 to C_{22} alkyl or alkenyl. [0004-0013]. R^3 is H; hydrocarbyl; particularly C_1 to C_{22} alkyl or alkenyl; a long chain alk(en)yl

succinic acyl group of the formula: $—OC(HR)C.C(HR^1).COY$

Where:

One of R and R^1 in the succinic moiety is C_8 to C_{22} alkenyl or alkyl and the other is hydrogen, and Y is a group OM where M is hydrogen, metal ammonium, amine especially alkylamine (including alkanolamines), or Y is NR^4R^5 where R^4 and R^5 are each independently hydrogen, a hydrocarbyl, particularly alkyl group, including substituted alkyl, particularly hydroxyl substituted hydrocarbyl, especially polyhydroxy hydrocarbyl, such as hydroxyl substituted and especially polyhydroxy substituted alkyl, groups; a long chain acyl group $-OC.R^6$ is along chain hydrocarbyl group, particularly a C_8 to C_{22} alkyl or alkenyl group [0018-0029] (which would satisfy the acyl group);

10. Regarding claim 24 and 25, **CARPENTER** teaches R^1 is the residue of sorbitol, which is a monosaccharide. [0055]

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11. Regarding claim 26, **CARPENTER** teaches R¹ represents the residue of sorbitol [0055].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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15. Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **CARPENTER** et al. (U.S. Patent Application Publication 2003/0153787, hereafter **CARPENTER**) in view of **BOUVY** et al. (U.S. Patent No. 6,613,817, hereinafter **BOUVY**).

16. Regarding claims 29-34, **CARPENTER** teaches the invention substantially as claimed, see paragraph 8. However, **CARPENTER** fails to teach the hydrocarbyl group comprising at least two ethylenic double bonds is derived from linoleic acid.

17. In the same field of endeavor, **BOUVY** teaches the hydrocarbyl group comprising 2 to 3 ethylenic double bonds is derived from linoleic acid (Col. 2, lines 15-17).

18. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the linoleic acid of **BOUVY** with the invention of **CARPENTER** since linoleic acid exhibits opposite geometric isomerism which is beneficial in the presence of strong bases.

19. With regard to claim 31, **BOUVY** teaches linoleic acid having an iodine value in the range from 45 g to 75 g, wherein the properties are intrinsic. The courts have held that “a compound and all its properties are mutually inseparable”, *In re Papesch*, 315F.2d 381, 137 USPQ 42, 51 (CCPA 1963). Further, attention is drawn to MPEP 2112.01, which states that “products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.”, *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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20. With regard to claim 34, **BOUVY** teaches linoleic acid (which satisfies two ethylenic double bonds). It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the proportions of fatty acids through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272,276,205 USPQ 215,219 (CCPA 1980). See also *In re Woodruff* 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F2d 454,456,105 USPQ 233,235 (CCPA 1955).

21. Claims 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **CARPENTER** et al. (U.S. Patent Application Publication 2003/0153787, hereafter **CARPENTER**) in view BOUVY et al. (U.S. Patent No. 6,780,910, hereinafter '**910**).

22. Regarding claims 35-41, **CARPENTER** teaches compounds of the formula (1):



Where: R^2 is the residue of a groups having at least m active hydrogen atoms derived from hydroxyl and/or amino and/or amido groups; AO is an alkylene oxide residue; each n is independently from 2 to 200; m is 2-10; and each R^2 is the residue of a group having at least m active hydrogen atoms derived from hydroxyl and/or amino and/or amido groups. R^3 is H, hydrocarbyl, particularly a C_1 to C_{22} alkyl or alkenyl. [0004-

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0013]. R^3 is H; hydrocarbyl; particularly C_1 to C_{22} alkyl or alkenyl; a long chain alk(en)yl

succinic acyl group of the formula: $\text{—OC}(\text{HR})\text{C}(\text{HR}^1)\text{COY}$

Where:

One of R and R^1 in the succinic moiety is C_8 to C_{22} alkenyl or alkyl and the other is hydrogen, and Y is a group OM where M is hydrogen, metal ammonium, amine especially alkylamine (including alkanolamines), or Y is NR^4R^5 where R^4 and R^5 are each independently hydrogen, a hydrocarbyl, particularly alkyl group, including substituted alkyl, particularly hydroxyl substituted hydrocarbyl, especially polyhydroxyl hydrocarbyl, such as hydroxyl substituted and especially polyhydroxyl substituted alkyl, groups; a long chain acyl group —OC.R^6 is along chain hydrocarbyl group, particularly a C_8 to C_{22} alkyl or alkenyl group [0018-0029] (which would satisfy the acyl group); However, **CARPENTER** fails to teach an aqueous emulsion or dispersion of polymeric particles wherein the emulsion or dispersion is formed in the presence of a stabilizing amount of a mixture of compounds represented by formula I.

23. Regarding claims 35- 41, **'910** teaches an aqueous emulsion or dispersion of polymeric particles comprising a compound of formula (I) as defined in claim 35 (Abstract; Col. 1, lines 54-67; Col. 4, lines 57-67) (as required by claim 36. **'910** teaches an aqueous emulsion or dispersion of polymeric particles wherein the polymeric particles comprise an alkyd resin (Abstract; Col. 1, lines 55-67; Col. 4, lines 40-55) (as required by claim 37). Also, **'910** teaches the alkyd resin is a resin which is the reaction product of (i) one or more polybasic organic acids or anhydrides, (ii) one or more monobasic fatty acid and one or more polyhydric alcohols (Col. 2, lines 52-60) (as

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required by claim 38). Furthermore, '910 teaches an aqueous emulsion of an alkyd resin which includes as an emulsifier a compound of formula (1) as defined in claim 1 in combination with an anionic surfactant, particularly an ether carboxylate, an alkyl aryl sulphonate, a phosphate ester, an alkyl ether sulfate, or a mixture of these surfactants, where the weight ratio of compound(s) of the formula (1) to anionic surfactant is in the range 90:10 to 10:90 (Column 3, lines 11-46) (as required by claim 39). '910 teaches a method of making an aqueous emulsion of an alkyd resin which comprises forming a mixture of the resin and surfactant, including at least one compound of formula as defined in claim 35, including water in the mixture to form a water-in-oil emulsion, and subsequently adding water to the water-in-oil emulsion at least until the emulsion inverts to form an oil disperse phase content of the emulsion to that desired (Column 5, lines 1-9) (as required by claim 40). '910 teaches polyester resins are well known with wide uses in surface coating such as paints (Column 1, lines 14-15) (as required by claim 41).

24. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have an aqueous emulsion or dispersion as taught by '910 with the invention of **CARPENTER** for the benefit of producing alkyd resin emulsions which are excellent as surface coatings, more specifically, industrial wood coatings.

Response to Arguments

25. Applicant's arguments filed 8/14/2009 have been fully considered but they are not persuasive. The response is insufficient to rebut the references made of record.

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Despite the applicant's argument in view of the teachings of **CARPENTER, BOUVY '817**, and **BOUVY '910** the position is maintained that the teachings and combinations of the references teaches the limitations of the applicant's claims, specifically taught in paragraphs 0018-0029. With regards to mixtures, the position is taken that one of ordinary skill would consider the disclosure of **CARPENTER** would immediately envisage mixtures, given the recitation of "compounds" and the differing compounds encompassed by the disclosed formula. It is noted applicant does not specify purity levels or any other limitations that the mixture are rendered to possess.

26. Furthermore, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEVE VALDEZ whose telephone number is (571)270-7738. The examiner can normally be reached on Mon-Thurs, 7:30pm-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DEVE VALDEZ/

/Rabon Sergent/
Primary Examiner, Art Unit 1796